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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HO, VIRGINIA T

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/549,499	Applicant(s) NOBLE, GARY PAUL	
	Examiner VIRGINIA HO	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-40, 43, 46, 50, 53 and 58-67 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-40, 46, 50, 53 and 58-67 is/are rejected.
- 7) ☒ Claim(s) 41, 42 and 48 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the request for reconsideration filed October 13, 2009.
2. Claims 46, 48, 50, and 53 have been amended. Claims 58-67 were added. Claims 44-45, 47, 49, 51-52, and 54-55 were cancelled.
3. Applicant's arguments, with respect to the claims, have been considered and are persuasive. However, new grounds of rejection are presented below.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 58-67 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, independent claim 58 is directed to an identification system, which in light of the specification, appears to encompass at least a purely software embodiment. In particular, the Examiner notes that the specification does not explicitly exclude such an interpretation, and thus the instant claim will be interpreted as being drawn towards *software per se*. Additionally, dependent claims 59-67 do not add any feature or subject matter that would solve the non-statutory deficiencies of claim 58.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 58 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim element “means for scanning” is a means (or step) plus function limitation that invokes 35 U.S.C.112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed function. In particular, applicant’s specification recites “Readers or *scanners* act as an interface between the transponders and a data environment. Transponders and the *means used to read them* are available [in] a number of forms. *Any suitable form can be used for the purposes of the present invention.*” (page 4, paragraph [040]). Additionally, the claim recites “means for comparing” and “means for permitting access” which do not appear to correspond to any particular structure in the specification. Additionally, the drawings illustrate a reader and data processing system which comprise of “reading means” “transmitting means” “receiving means” and “data processing means” (*Fig. 1A*) but do not appear to represent any particular structure nor do they appear to correspond to any of the claim functions (“*means for comparing*” and “*means for permitting access*”).

Applicant is required to:

(a) Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or

(b) Amend the written description of the specification such that it expressly recites what structure, material, or acts perform the claimed function without introducing any new matter (35 U.S.C. 132(a)).

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If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

(a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or

(b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181.

8. Claims 61-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite “means for randomly selecting the N tags,” “means for providing a checksum mechanism,” “means for sorting,” “means for authenticating,” and “means for generating a digital certificate” which invoke 35 U.S.C. 112, sixth paragraph. However, the written description fails to disclose the corresponding structure, material, or acts for the claimed functions. Additionally, the drawings illustrate a reader and data processing system which comprise of “reading means” “transmitting means” “receiving means” and “data processing means” (*Fig. 1A*) but do not appear to represent any particular structure nor do they appear to

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correspond to any of the claimed functions (“*means for randomly selecting the N tags,*” “*means for providing a checksum mechanism,*” *etc.*).

Response to Arguments

9. Applicant’s arguments, see pages 9-12, 15, 17 filed October 13, 2009, with respect to the rejection(s) of claim(s) 38-39, 46, 53 under 35 U.S.C. § 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hawley et al. (*US Pre-Grant Publication 2001/0021950*).

10. Applicant’s arguments, see page 13-14, filed October 13, 2009, with respect to the rejection(s) of claim(s) 43 and 50 under 35 U.S.C. § 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Hawley and Garber.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 38-39 and 58-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Hawley et al. (*US Pre-Grant Publication 2001/0021950*) (*hereinafter Hawley*) (*previously presented in Applicant’s IDS*).

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As per claims 38 and 58, Hawley teaches an identification method and system, comprising:

a radio frequency identification (RED) reader (Fig. 1, item 15) scanning a user to read N Radio Frequency Identification (RFID) tags respectively embedded in N objects being carried by the user (paragraph [0024], token includes small items (such as easily carried cards or 'poker chip' disks) intended as housings for the RFID tag, as well as commonplace articles such as keychains, product containers, and household appliances that incorporate the RFID tag), each tag of the N tags comprising a tag identifier of said each tag (paragraph [0011], the tag identifies the token, the tag reader reads the identifier), said N being at least 2 (paragraph [0016], access criteria is not limited to a single token. "The user may place a plurality of tokens within the range of the reader");

comparing the N tags read by the RFID reader with M tags in a registered record of data (paragraph [0033], database contains a series of access criteria, each of which is matched to an identifier or group of identifiers; paragraph [0011], "Generally, the computer maintains a database relating token identifiers to associated network-access criteria, and consults the database when presented with an identifier"), said registered record comprising a reference to the user (paragraph [0017], the database record for each identifier can include the student's name), each tag of the M tags comprising a tag identifier, said M being at least N (paragraph [0016], "The user may place a plurality of tokens within the range of the reader, the access criterion being determined by all the identifiers detected by the reader"); and

permitting access by the user to a resource if said comparing has determined that the tag identifiers in the M tags comprise the tag identifiers in the N tags read by the RFID reader

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(paragraph [0014], the computer looks up the access criterion and takes the action specified.

“In this way, access to a specific, restricted file may be obtained merely by bringing the token into proximity to the reader”).

As per claims 39 and 59, Hawley teaches the invention of claims 38 and 58 (respectively), as applied above. Hawley additionally teaches the method, wherein $M = N$ *(paragraph [0016], access criteria is not limited to a single token. “The user may place a plurality of tokens within the range of the reader, the access criterion being determined by all the identifiers detected by the reader”; thus $M \geq 2$, the user presents $N \geq 2$ tokens, and all N tokens are used in the determination of satisfying the access criterion).*

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 38 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley, in view of Steeves (*US Patent 7,005,985*).

As per claims 40 and 60, Hawley teaches the invention of claims 38 and 58 (respectively), as applied above. Hawley does not explicitly teach the method, wherein M exceeds N . However, Steeves teaches an access control system whereby a person approaches an access door with an asset (e.g. laptop or personal computer) and the attached primary tag

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(column 21, lines 7-11). For instance, a particular embodiment is exemplified whereby “the primary tag determines if passage through access door 242 is permitted. If a responding secondary tag is on the list of linked secondary tags, exit may be approved” *(column 22, lines 11-15)*. In this manner, it is clear that the number of presented tags *(secondary tags carried by the person in addition to the primary tag attached to the asset; ‘a responding tag’)* is less than the totality of tags necessary *(list of linked secondary tags to be presented which accompany the primary tag; ‘is on the list’)*.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Hawley such that the number of M tags *(in the data record)* exceeds the number of N tags *(presented)*, as Steeves teaches that doing so allows the access control system to provide “many levels of control” *(column 21, lines 25-27)*.

15. Claims 46 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley, in view of Freund *(US Pre-Grant Publication No. 2003/0187787)* *(previously presented)*.

As per claims 46 and 64, Hawley teaches the invention of claims 38 and 58 (respectively), as applied above. Hawley does not explicitly teach the invention, wherein prior to said scanning the method further comprises authenticating the user during a registration process in which the registered record is generated. However, Freund teaches a user who must be authentication during a registration process *(paragraph [0038])*. It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Hawley to authenticate the user prior to scanning, as doing so ensures that the user is tied to the object which he carries.

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16. Claims 43, 50, 63 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley, in view of Garber et al. (*US Patent 6,448,886*) (*hereinafter Garber*).

As per claims 43 and 63, Hawley teaches the invention of claims 38 and 58 (respectively), as applied above. Hawley does not explicitly teach the method, wherein after said scanning the method further comprises sorting the tag identifiers in the N tags read by the RFID reader. However, Garber teaches utilizing RFID technology to sort items (*column 8, lines 15-19*). It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Hawley to sort the tag identifiers after being scanned, as doing so allows one to efficiently determine that all items are successfully identified (*column 8, lines 12-15*).

As per claims 50 and 66, Hawley teaches the invention of claims 38 and 58 (respectively), as applied above. Hawley does not explicitly teach the invention, wherein a tag identifier in a first tag of the N tags includes an indication of a type of the object in which the first tag is embedded. However, Garber teaches storing information relating to the type of object on an RFID tag itself (*column 7, lines 64-67*). It would have been obvious for one of ordinary skill in the art at the time of the invention to include an indication of a type of the object in which the tag is embedded, as Garber teaches that immediately knowing a (*media*) type of an object allows a management system to insure that the item is appropriately processed quickly and efficiently, without “incurring the delay and inconvenience” of consulting a remote database (*column 8, lines 3-7*).

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17. Claims 53 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawley, in view of Nerlikar (*US Patent 5,629,981*) (*previously presented*).

As per claims 53 and 67, Hawley teaches the invention of claims 38 and 58 (*respectively*), as applied above. Hawley does not explicitly teach the invention, wherein the M tags in the registered record have an expiration time. However, Nerlikar teaches an access control system utilizing RFID transponder badges, whereby authorization is subject to expiration when a specified period of time ends (*column 13, lines 57-67*). It would have been obvious for one of ordinary skill in the art at the time of the invention to modify Hawley to set an expiration time for the M tags of a registered record, as Nerlikar teaches that “this is useful if an individual is working on a project for a specific period of time, as the individual’s authorization to access a resource such as a location can be automatically cancelled upon the completion of the project” (*column 13, lines 57-67*).

Allowable Subject Matter

18. Claims 41-42, 48-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

19. Claims 61-62, and 65 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIRGINIA HO whose telephone number is 571-270-7309. The examiner can normally be reached on Mon to Thu; 8:30 AM - 5:00 PM (Eastern).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VIRGINIA HO/
Examiner, Art Unit 2432

/Gilberto Barron Jr./
Supervisory Patent Examiner, Art Unit 2432